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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,087	10/04/1999	GARY L. BURGE	1355-171C	9198
8698	7590	08/15/2006	EXAMINER	
STANDLEY LAW GROUP LLP 495 METRO PLACE SOUTH SUITE 210 DUBLIN, OH 43017			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,087

Applicant(s)

BURGE ET AL

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 31 May 2006 have been fully considered but they are not persuasive. The arguments are addressed by revision of the rejection to accommodate the amendment and expressly at para. 7 and 8 below. Suggestions for overcoming the instant rejection are in para. 13 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 5, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemon et al. (US pat. 4,674,041).
5. Lemon et al. teaches (independent claims 1 and 16) a system for customizing displays and an electronic marketing system, the electronic marketing system comprising: a plurality of electronic user profiles (*customer credit account numbers and coupon transaction histories* stored in *memory 56*, col. 8 lines 32-37); a database (*memory 56*) for storing *coupons to be displayed* (col. 8 lines 32-36), the merchant-selected details of said *coupons* reading on merchant data for a plurality of merchants (col. 3 lines 36-38 and 61-62); variable display characteristics (*full screen advertisements or a page formatted menu of coupons*, col. 6 lines 62-67) for defining the layout of a computer display; a predictive model for selecting actual display characteristics consistent with said variable display characteristics (i.e., selecting the

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sequence and number of pages for display of coupons and ads, col. 5 lines 32-44), said actual display characteristics independent of said merchant data (i.e., independent of the details of the coupons offered by merchants to the customer user), and conforming to monitored user preferences (the *coupon transaction histories*) for presentation of merchant data (the merchant-selected details of the coupons) on said computer display (col. 5 lines 8-11) in accordance with one of said electronic user profiles/*coupon transaction histories*; and a computer display comprising said actual display characteristics and said merchant data from said plurality of merchants, said computer display conforming to monitored user preferences/*coupon transaction histories* based on said actual display characteristics for presentation of said merchant data.

6. For claim 1, Lemon et al. also teaches a process at a host computer (*host computer H*) for selecting a plurality of actual display characteristics (col. 4 lines 35-40), and a "shopper's computer" (*terminal T with customer interface*, col. 4 lines 15-22 and Fig. 2; see para. 11 below). The customer/user purchases based on coupon chosen with the reference invention (col. 2 lines 8-12) reads on *on-line behavior data*.
7. Applicant argues (p. 10 of 16, middle of bottom para.), "User profile data is defined in [specification] paragraphs 28 and 29 as data collected while a user navigates a shopping environment and data provided by the user when joining the service." Applicant is not correct. The subject paragraphs are much longer and more general than the alleged definition. The subject paragraphs disclose, for example, "The present invention ... records an on-line user's ... shopping purchases ...". As noted above, the reference teaches that. If applicant wants a narrower meaning, applicant need only add limitations from the spec. to the claims. Para. 13 below offers suggestions.
8. Applicant also argues (p. 11 of 16, bottom) that "merchant data" is clearly defined as "the general merchant data and specific product and service merchant data (i.e., merchant data)". The examiner agrees that that is clear, but it is also so broad as to subsume the interpretation used herein (para. 5): merchant-selected details of the coupons reads on "merchant data".
9. Lemon et al. also teaches at the citations given above claims 2, 5 and 18. Claim 2 does not add a patentable, structural, limitation to claim 1. Even if it did, the plurality of *terminals T* (col. 4 lines 15-22) would read on "selected sites".

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10. Claims 3, 4, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being obvious over Lemon et al. (US pat. 4,674,041).
11. Lemon et al. does not teach (claims 3 and 17) that personal data includes age, sex and hobbies. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to monitor these demographic parameters for marketing purposes. Lemon et al. also does not teach (claims 4, 19 and 20) that the coupons/display model parameters include colors. It was common, at the time of the instant invention, to produce colored coupons.
12. Official notice of these common knowledge or well known in the art statements was taken in the last Office action (para. 15 and 16, mailed on 6 February 2006). These statements are taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)

Suggestion of Allowable Subject Matter

13. The specification contains limitations that could be claimed to overcome the instant rejection. The two that appear to have the most promise are as follows.
 - (1) Lemon et al. does not teach or suggest that the *shopper's computer 80* is connected to the network via an on-line subscription service. This limitation is disclosed at col. 4, lines 30-39 of the parent patent (US006014638A).¹
 - (2) Lemon et al. does not teach or suggest on-line purchasing. This limitation is disclosed at col. 4, lines 1 and 17, of the parent patent (US006014638A). Note that the limitation "on-line shopping" would not overcome the instant rejection because "shopping" includes merely considering a purchase. Similarly, Lemon et al. does not teach or suggest that the *terminal/shopper's computer 80* is remote from a point of sale. This limitation is disclosed at Fig. 1 and the associated text of the parent patent (US006014638A).

Other patentable limitations are readily possible. Should applicant have a specific other alternative and chose to re-start prosecution with an RCE, it would be appropriate to ask the examiner in an interview if that specific alternative would overcome the instant rejection.

¹ The examiner does not have access to the specification as filed at the time of this writing.

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14. Applicant is cautioned that an allowance could not be considered until any amendment was searched. In addition, allowance is subject to successful vetting by an Allowance Conference.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
16. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
18. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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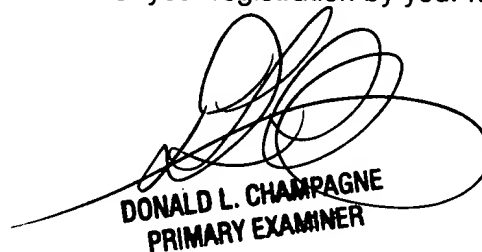
20. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

21. Applicant may have after final arguments considered and amendments entered by filing an RCE.

22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

29 July 2006



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
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